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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,218	04/06/2004	Phyll Cammack	DEKA:342US	7111
32425 7590 01/30/2007 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER KUBELIK, ANNE R	
			ART UNIT	PAPER NUMBER
			1638	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/30/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,218

Applicant(s)

CAMMACK, PHYLL

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/6/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are pending.
2. The specification is objected to for having a blank line on pg 22, lines 4-5.

Claim Objections

3. Claims 6 and 15-16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. The claimed plants do not have all the characteristics of the plant of claim 2. Because the plant of claim 6 is male sterile, it cannot have all the traits of the plant of claim 2, which is male fertile. Because the plant of claim 15 has a transgene, it cannot have all the traits of the plant of claim 2, which does not have a transgene (and if it does, then the claim fails to further limit claim 2). Thus, the claims do not properly depend from the parent claim.
4. Claim 6 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 8. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-24 are rejected under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If a seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted that Applicant intends to deposit seeds for corn variety I002573 at the ATCC (See specification at pg 22, lines 1-10), but there is no indication that the seeds have been deposited and there is no indication in the specification as to public availability. If the deposit of these seeds is made under the terms of the Budapest Treaty, then an affidavit or declaration by the Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. A minimum deposit of 2500 seeds is considered sufficient in the ordinary case to assure availability through the period for which a deposit must be maintained.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit, meets the criteria set forth in 37 CFR 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

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(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;

(d) the viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.801 - 1.809 [MPEP 2401-2411.05] for additional explanation of these requirements.

7. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. Selection steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. The specification on pg 3, lines 1-9, requires selection of desired phenotypes. Further, producing an inbred requires the each generation of crossing involves either crossing the plants to themselves or a second plant, but not alternating between the two, as encompassed by the claims. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

8. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Selection steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification on pg 22, line 12, to pg 23, line 23, requires selection of the traits in each round of crossing.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 14, 16, 19-21 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

In claim 14, part (a), the relation of the first and second corn plant to corn variety I002573 and the second distinct corn plant, as recited in parent claim 13, is unclear. Further, preventing self-pollination of only one of the inbred corn plants would not endure that all the seeds would be hybrid, as required by the parent claim.

In claims 16 and 21 it is unclear how the plant can have the trait of restoration of male fertility because I002573 is already male fertile.

In claim 19, the phrase "comprising a plurality ... each locus" in lines 3-59-11, 11-13, 21-23, and 31-33 are confusing, as the phrases do not appear to further limit the plant or seed, as they describes an inherent feature of the plant or seed.

In claim 20 it is unclear into which corn genome the genetic locus was inserted.

The terms "improved" and "modified" in claims 16 and 21 are relative terms that render the claims indefinite. The terms "improved" and "modified" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What are the traits "improved" and "modified" relative to?

In claim 23 the recitations of the phrase "comprise a diploid genome ... each locus" are confusing, as the phrases do not appear to further limit the hybrid corn seed, as they describes an inherent feature of the hybrid corn seed.

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11. Claims 1-24 are free of the prior art, given the failure of the prior art to teach or suggest an inbred corn plant with the characteristics of corn variety I002573. The closest prior art is the plant taught by Arthur (1997, US Patent 5,633,428), but that plant differs from the instant plant in that it has a light green husk instead of a green one and loose husk opening instead of a tight one.

Conclusion

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.
January 11, 2007